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EXAMINER

LUGO, CARLOS

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3676

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/761,135

Applicant(s)

WALLS ET AL.

Examiner

Carlos Lugo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 24, 25 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 26-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-23 and 26-32, drawn to a device for operating a lock assembly, classified in class 292, subclass 100.
  - II. Claims 24,25, and 33, drawn to a handle assembly, classified in class 292, subclass 336.3.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions in Group I and in Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require that the member or tail pin has a first position and a second position and that the first position of the handle when the member is in the first position is the same as the first position of the handle when the member is in the second position. The subcombination has separate utility such as a device wherein the member is not directly connected to the lock or that the handle is not directly connected to the member.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Mr. Paul Nykasa on March 10, 2005 a provisional election was made with oral traverse to prosecute the invention of Group I, claims 1-23 and 26-32. Applicant in replying to this Office action must make affirmation of this election. Claims 24,25, and 33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

#### ***Specification***

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The

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disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The abstract of the disclosure is objected to because of the phrase "is disclosed" in lines 1 and 2. Correction is required. See MPEP § 608.01(b).
6. The specification is objected to because of the following informalities:
  - Page 6 Line 11, change "the second aperture 54' to -the second aperture 55-.Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:
  - The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
8. **Claims 1-21 and 26-32 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1,20,26, and 32 recites that the member has a first position and a second position. It is not clear what the applicant is trying to claims as his invention since the member only shows one position.

If the applicant is trying to claim that the device is capable of being positioned with respect to a door in two different positions, i.e., right or left side of the door, then appropriate correction is required.

In order to continue with the examination, the claims will be considered as the member being capable of having different positions with respect to the position of the device with respect to the door.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1-10,17,18,20-29, and 32 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 4,671,089 to Fleming et al (Fleming '089) in view of US Pat No 5,092,144 to Fleming et al (Fleming '144).

Regarding claims 1-3,20-23,26,29, and 32, Fleming '089 discloses a device (10) for operating a lock assembly (84) comprising a member (87) that is structure adapted to cooperate with the lock assembly; a handle (26) operable and adjustable connected to the member; and an adapter (101) connecting the member with the handle.

However, Fleming '089 fails to disclose that the device is capable of being mounted in either side of the door.

Fleming '144 teaches that it is well known in the art to have a device (10) for operating a lock assembly, wherein the device is capable of being mounted in either side of the door (Figures 1,2,24, and 25).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a device capable of being mounted in either side of the door, as taught by Fleming '144, into a device as described by Fleming '089, in order to have a device that can adjust to any type of door.

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As to claims 4 and 5, Fleming '089 discloses that the handle, when is in the unlocked position, has a generally vertical configuration and when it is in the locked position, the handle has a generally horizontal configuration (Col. 7 Lines 50-54).

As to claims 6 and 7, Fleming '089, as modified by Fleming '144, discloses that the member structure (87) is adapted to cooperate with the lock assembly configured for a right or left hand door.

As to claims 8-10, Fleming '089 discloses that the second position of the handle is rotationally displaced from the first position of the handle.

As to claim 17, Fleming '089 illustrates that the member has a generally rectangular cross-section adapted to cooperate with an aperture of a lock member of the lock assembly.

As to claim 18, Fleming '089 discloses that the handle is a thumbturn.

As to claims 27 and 28, Fleming '089 illustrates that the cross-section of the member is a quadrilateral.

11. **Claims 11-16 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 4,671,089 to Fleming et al (Fleming '089) in view of US Pat No 5,092,144 to Fleming et al (Fleming '144) as applied to claim 1 above, and further in view of US Pat No 4,453,753 to Fayerman et al (Fayerman '753).

Fleming '089, as modified by Fleming '144, fails to disclose that the member is offset to a vertical axis. Fleming '089 and Fleming '144 disclose that the member is aligned with a vertical axis.

Fayerman '753 teaches that it is well known in the art to have a handle (20) connected to a member (30), which is connected to a lock assembly, wherein the member (30) is offset from a vertical axis (Figure 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the member offset from a vertical axis, as taught by Fayerman '753, into a device as described by Fleming '089, as modified by Fleming '144, because the fact that the member is offset or not from a vertical axis is considered as a design consideration within the art because the position of the member does not affect the mechanism movement.

12. **Claims 19,30, and 31 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 4,671,089 to Fleming et al (Fleming '089) in view of US Pat No 5,092,144 to Fleming et al (Fleming '144) as applied to claim 1 above, and further in view of US Pat No 299,633 to Flinn.

Fleming '089, as modified by Fleming '144, fails to disclose that the handle has first and second apertures so as to receive a fastener to connect the member to the handle.

Flinn teaches that it is well known in the art to have a handle (A and B) connected to a member (D), wherein the handle presents first and second apertures (a, b, and c) so as to receive a fastener (f) in order to connect the member and the handle at a desire configuration.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a handle with several apertures, as taught by Flinn, into



a device as described by Fleming '089, as modified by Fleming '144, in order to connect the member and the handle at a desire configuration.

**Conclusion**

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo whose telephone number is 703-305-9747 or 571-272-7058 (after March 31, 2005). The examiner can normally be reached on 9-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

C.L.

Carlos Lugo  
AU 3676

March 10, 2005



DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
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